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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/697,157
Filing Date: October 31, 2003
Appellant(s): EMORI, KAZUKI

Carl Schadkowitz
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed August 25th, 2008 appealing from the Office action mailed January 25th, 2008.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the Brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

JP 10174738	Sakamoto	6-1998
WO 98/05575	Corsetti	2-1998

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1 and 3-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Sakamoto (JP 10174738 A).

Regarding Claim 1. Sakamoto discloses a gaming machine comprising: a cabinet having a front side (Fig. 3, 4); a cover/belly panel releasably connected to the cabinet and operable to move to a cover state where a portion of the front side of the cabinet is covered by the cover/belly panel and an exposed state where the portion of the front side of the cabinet is uncovered when the cover/belly panel is positioned away from the cabinet (5: Fig. 2, 3); a symbol row display device configured to display a plurality of symbols for a player to arrange the symbols (Fig. 4); an operation input device comprising a lever or a button to be operated by the player to play a game (Fig. 4); an internal lottery device configured to carry out an internal lottery of the game with a random number (Fig. 4: it is well known in the art that a random number generator is used to determine the combination of the symbols); an illumination device configured to illuminate a tray formed on a cabinet of the gaming machine (25: Fig. 2, English translation of abstract); a transparent member placement part attached to the portion of the front side of the cabinet (22a: Fig. 2); and a transparent member detachably disposed between the illumination device and the tray (26, Fig. 1), wherein, when the belly panel is in the exposed state, the transparent member placement part is operative to receive the transparent member and, when the belly panel is in the cover state, the transparent member is inherently received by the transparent member placement part such that the transparent member is positioned between the cover/belly panel and the portion of the front side of the cabinet thereby retaining the transparent member substantially immovable there between (22, 26, 24: Fig. 1, 2).

Regarding Claim 3. Sakamoto further discloses wherein the transparent member is formed of a plastic member (para 2 of English translation of abstract: plastics are made of resins).

Regarding Claim 4. Sakamoto further discloses wherein the transparent member is sandwiched and fixed (26, Fig. 1) between the cabinet (24, Fig. 1) and a belly panel fitted into the cabinet (22, Fig. 1).

Regarding Claim 5. Sakamoto further discloses wherein the transparent member is colored (para 2 of English translation of abstract: resins can be of various colors).

Regarding Claim 6. Sakamoto further discloses wherein the transparent member is decorated with a decoration including at least one of a character, a sign, and a design (para 2 of English translation of abstract).

Claims 1 and 3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakamoto.

Regarding Claim 1: Sakamoto discloses the claimed invention except for a detachable transparent member. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a detachable member for ease of maintenance, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179. See MPEP 2144.04 (V)(C)

Regarding Claims 3-6: See 35 USC Sec. 102 rejections of claims 3-6 above.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sakamoto in view of Corsetti (WO 98/05575). The teachings of Sakamoto have been discussed in claim 1 above.

However, Sakamoto fails to disclose wherein the transparent member comprises: a bottom member configured to transmit light from the illumination means; a rear member fixed to the bottom member substantially at right angles therewith; and a side member fixed between the rear member and the bottom member.

Corsetti teaches the transparent member comprises (Fig. 1; page 10, lines 3-7): a bottom member configured to transmit light from the illumination means (30, Fig. 1: the transparent plastic allows light to pass through); a rear member fixed to the bottom member substantially at right angles therewith (20, Fig. 1); and a side member fixed between the rear member and the bottom member (38, Fig. 1).

Therefore, in view of Corsetti, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the aforementioned limitations in order to allow the transparent member to be inserted/removed easily into/from the cabinet of the gaming machine (page 3, lines 1-5).

Alternatively, claim 2 is rejected on the matter of design choice. The transparent member still utilizes the bottom member to transmit light from the illumination device. In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). See MPEP 2144.04 (IV)(B).

(10) Response to Argument

Rejection of Claims 1 and 3-6 under 35 U.S.C. 102

The appellant's first argument begins at page 5 of the brief. Appellant argues that Sakamoto fails to anticipate each and every element of claim 1. In response, the Examiner is withdrawing the 102(b) rejection.

Alternative Rejection of Claims 1 and 3-6 under 35 U.S.C. 103

The appellant argues, on page 9, that the applied art fails to teach or suggest that:

1. "the cabinet has a front side and the belly panel is releasably connected to the cabinet and is operable to move to a cover state where a portion of the front side of the cabinet is covered by the belly panel and an exposed state where the portion of the front side of the cabinet is uncovered when the belly panel is positioned away from the cabinet."

In response, Sakamoto does disclose the cabinet having a front side with a belly panel (5, from Figure 2 & 3), wherein the belly panel is connected to the cabinet in a way where it is able to be removed or released (as can be seen on Figure 2, the belly panel is released or removed, wherein the internal components in the front cabinet is

shown). Since the internal components need to be protected from external damaging, the belly panel is obviously used to cover the front cabinet. The exposed state would be when the belly panel is removed or positioned away from the cabinet.

While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In *re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also *In re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). In this case, the belly panel of Sakamoto is also operable to be moved to a cover or exposed state.

For the reasons noted above the examiner's rejection should be sustained.

2. "a transparent member placement part is attached to the portion of the front side of the cabinet."

In response, Sakamoto does disclose a transparent member placement part (22a, from Figure 2) being attached to the portion of the front side of the cabinet because the transparent resin plate or member (26, from Figure 2) has to have an

object to sit on or support it since the transparent resin plate or member is movable. In the English translated copy of Sakamoto submitted by Appellant on April 28, 2008, Sakamoto discloses a transparent resin plate to carry out a form of advertisement and promotion by making it into a message to the game person (para 0023), which can also be seen in 27, from Figure 3. Because the transparent resin plate is used to present promotional messages, it would have been obvious to a person of ordinary skill in the art during the time of invention to make the transparent resin plate interchangeable in order to present different promotional messages.

For the reasons noted above the examiner's rejection should be sustained.

3. "when the belly panel is in the exposed state, the transparent member placement part is operative to slidably receive the transparent member and when the belly panel is in the cover state, the transparent member is slidably received by the transparent member placement part such that the transparent member is positioned between the belly panel and the portion of the front side of the cabinet thereby retaining the transparent member substantially immovable therebetween."

In response, Sakamoto does disclose the transparent member, as mentioned above, to be interchangeable.

While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference

relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also *In re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). In this case, the transparent member placement part of Sakamoto is also operable to slidably receive the transparent member when the belly panel is in the exposed state since the transparent member can be interchangeable. When the belly panel is in the cover state, the transparent member is slidably received by the transparent member placement part such that the transparent member is positioned between the belly panel and the portion of the front side of the cabinet thereby retaining the transparent member substantially immovable therebetween (because the transparent member sits on the transparent member placement part, the transparent member substantially immovable).

For the reasons noted above the examiner's rejection should be sustained.

Rejection of Claim 2 under 35 U.S.C. 103

The appellant argues, on page 12, that the Corsetti teaches a removable insert for coin trays.

In response, while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44

USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also *In re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original).

"In *United States v. Adams*, . . . [t]he Court recognized that when a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result." *Id.* at ___, 82 USPQ2d at 1395.

In this case, Corsetti discloses a removable insert for coin tray. Since Sakamoto does not expressly disclose the structure of the transparent member, the examiner is only using the structure already known in the prior art of a removable insert (i.e. transparent member) of Corsetti and not its function. Altering the Sakamoto's apparatus by the mere substitution of one element (i.e. transparent member or removable insert) for another known in the field yields a predictable result which still results in light being transmitted through the bottom member of the transparent member.

Alternatively, claim 2 was rejected on a matter of design choice, because it would have been an obvious matter of design choice to modify the structure of the transparent member, since appellant had not disclosed that changing the structure of the

transparent member solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with both structures, which is the transparent member still utilizes the bottom member to transmit light from the illumination device.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Seng H Lim/

Examiner, Art Unit 3714

Conferees:

/XUAN M. THAI/

Supervisory Patent Examiner, Art Unit 3715

/Thomas Barrett/

TQAS TC3700